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09/475,912	12/30/1999	PERRY A. PIERCE	E-925	7042

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EXAMINER

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ART UNIT PAPER NUMBER

3625

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/475,912
Filing Date: December 30, 1999
Appellant(s): PIERCE, PERRY A.

Ronald Reichman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 August 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

For purposes of this appeal, the Examiner withdraws rejection under 35 USC 101 and 35 USC 112.

(7) Grouping of Claims

Appellant's brief groups claims 1, 3, 4, 6, 7, 9, 16, 17, 19, 23 and 24 together

Appellant's brief groups claims 10, 11, 12, 13, 14, 15, 20, 21 and 22 separately.

(9) Prior Art of Record

5892900

Ginter

04-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-7, 9-17, 19-24 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on 22 March 2004.

(11) Response to Argument

Appellant argues that Ginter does not disclose certain limitations of his invention.

The Examiner respectfully disagrees for reasons stated in the last office action. However, the Examiner will take this opportunity to further elaborate on the rejection and to further clarify the record. The Examiner respectfully notes that these remarks do not constitute new grounds for rejection, but merely serve to expound upon the previous rejection.

In **Argument A**, pages 15-19, Appellant comments concerning the rejection of claims 1, 3, 4, 6, 7, 9, 16, 17, 19, 23 and 24. Appellant's remarks are directed only to representative claims 1 and 17. Appellant argues, page 18, that Ginter does not

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disclose or anticipate Claim 1, paragraphs vi, vii and viii and related claim 17, steps (e), (f) and (g).

The Examiner will focus his discussion on representative method claim 17, which calls for

e) deducting a monetary sum from the fund and crediting the deducted sum to the seller, wherein the fee for downloading the data item in its entirety has a range specified by the Seller and defined by a maximum amount, and a minimum amount wherein the maximum amount is the fee posted by the Seller, and a minimum amount is what the Seller is willing to collect from the buyer for downloading the data item so that the buyer is allowed to download the data item if the buyer's proposed monetary sum for downloading the data item is greater or equal to the minimum amount specified by the seller

The Examiner respectfully notes, however, that even if one were to interpret claims 1 and 17 so as to give full patentable weight to each aspect of step (e), Ginter discloses each of the implied step limitations. For example:

- ...fee for downloading has a range specified by the content creator (seller). Fig. 75A, Col. 272, line 61-Col. 273, line 22).
- ...the range is specified by a maximum amount (\$100) and a lower amount (\$25).
- ...the maximum amount is posted by the seller. Col. 272, lines 16-22, the preferred amount is offered first in a negotiation process.
- ...the minimum amount (\$25) is what seller is willing to collect from the buyer for downloading the data item.
- ...Ginter compares the buyer's offer with the minimum amount. Col. 274, line 52-Col. 275, line 6.
 - IF buyer's offer (\$150, \$30) is greater than or equal to the minimum amount (\$25).
 - ...buyer is allowed to download the data item, Col. 1, line 42-Col. 2, line 32, Fig. 3 ("supply content to user").
 - ...monetary sum is deducted from the fund. Col. 261, lines 10-48.
 - ...monetary sum is credited to the seller. Col. 261, lines 10-48.

Appellant argues, pages 18-19, that Ginter does not disclose or anticipate certain scenarios.

Ginter does not disclose or anticipate a scenario in which the seller may say he/she wants \$1.00 for the item, and the buyer may propose \$.85. If the \$.85 is within the seller's range, the item is purchased. However, if the \$.85 is not within the seller's range, the item is not purchased.

Ginter uses a fixed ("higher") price for using the content and another fixed ("lower") price for using the content with additional control information and field specifications requiring

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collection and return the user's personal information. Ginter does not automatically check the offered price by the buyer to determine whether the posted offer falls within the range specified by the seller.

The Examiner respectfully notes, however, that the features upon which Appellant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant argues

Ginter does not automatically check the offered price by the buyer to determine whether the posted offer falls within the range specified by the seller.

The Examiner disagrees. The Examiner respectfully directs the Board's attention to at least Col. 274, line 52-Col. 275, line 29, which discloses that Ginter automatically checks offered amounts to determine whether an offer is greater than or equal to a minimum amount specified by a seller.

Concerning steps (f) encryption and (g) digital signatures, Appellant argues:

Ginter does not to encrypt the data item prior to downloading the data item to the buyer to prevent an unauthorized person from obtaining the downloaded data item by interception', and provide a digital signature to the buyer to allow the buyer to verify the authenticity of the downloaded data item through a certification authority.

The Examiner respectfully disagrees for reasons stated in prior office actions:

- step (f), encryption, please see at least Col. 127 line 56 to Col. 128 line 3, Col. 174 line 1 to 22, Col. 209 line 3 to 23, Col. 221 line 53 to 67, Col. 223 line 28 to 44, Col. 229 line 14 to 30, Col. 234 line 55 to Col. 235 line 13, Col. 253 line 8 to 65, Col. 338 line 11 to 28.
- Step (g), digital signatures, Ginter provides digital signatures to buyers. For example, see references to encryption and public keys provided to buyers, at least in

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Col. 7 line 58 to Col. 8 line 7, Col. 21 line 40 to 59, Col. 29 line 19 to Col. 30 line 39, Col. 146 line 54 to Col. 147 line 4, Col. 203 line 29 to 45, Col. 210 line 49 to 58, Col. 226 line 21 to 38, Col. 234 line 55 to Col. 235 line 13, Col. 239 line 15 to 25, Col. 257 line 8 to Col. 258 line 3, Col. 261 line 10 to 48, Col. 270 line 66 to Col. 271 line 36, Col. 272 line 62 to Col. 274 line 17, Col. 299 line 8 to 59.

- Step (g) digital certificates and certification authority. See, for example, at least Col. 211 line 39 to 67, Col. 219 line 21 to 31, Col. 225, line 58-Col. 227 line 42, Col. 261 line 10 to 48, Col. 273, line 40-Col. 274, line 51.

The Examiner notes that Ginter does not use the terms “buyer” and “seller.” *Ginter* uses the terms content creators, content distributors, etc., to refer to applicant’s sellers. Ginter refers to buyers as users. However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as *Ginter* because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

Concerning claim 5, Argument B, page 20, Appellant argues that Ginter does not disclose or anticipate a user fee or commission deducted from a fee credited to a

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seller. A commission is a fee paid to an agent or employee for transacting a piece of business or performing a service, esp a percentage of the money received from a total paid to the agent responsible for the business (definition of commission, MERRIAM WEBSTER Collegiate Dictionary). Ginter discloses that an organization offering the repository's services may charge a service fee on a per transaction basis and/or as a percentage of the payments by and/or cost of, the content to users. See, for example, at least Col. 308, lines 25-35. These are commissions.

Concerning claim 10, Argument C, page 20, Appellant argues that Ginter does not disclose or anticipate that a seller uses an identification code to modify a data item and/or fee. The Examiner respectfully disagrees and directs the Board's attention to at least Col. 294, line 52-Col. 295, line 7, for example.

Concerning claim 11, Argument D, page 20, Appellant argues that Ginter does not disclose or anticipate storing an excerpt of a data item. The Examiner respectfully disagrees and directs the Board's attention to at least Col. 200, lines 25-36 concerning excerpts.

Concerning claim 12, Argument E, page 21, Appellant argues that Ginter does not disclose or anticipate using an administrative unit to notify a user of problems related to use of the repository. The Examiner disagrees and respectfully directs the Board's attention to a section entitled "User Notification Exception Interface" and user notifications, Col. 262, line 40 – Col. 264, line 42.

Concerning claim 13, Argument F, page 21, Appellant argues that Ginter does not disclose or anticipate that data storage may include plurality of data banks each of

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which is used to store a data item and an excerpt of said data item. The Examiner disagrees and respectfully directs the Board's attention to at least references to plurality of databases and to distributed databases, at least Col. 152, lines 4-16, Col. 307, line 5-Col. 308, line 61.

Concerning claims 14 and 21, Argument G, page 22, Appellant argues that Ginter does not disclose or anticipate where a fund is deposited in a bank and the deposited fund can be withdrawn by the system to pay for downloading a data item. The Examiner disagrees and respectfully directs the Board's attention to at least Col. 261, lines 10-48.

Concerning claims 15 and 22, Argument G, Appellant argues, page 22, that Ginter does not disclose or anticipate where the fund is stored in a stored-value card and the stored fund can be withdrawn by the repository to pay for downloading a data item. The Examiner disagrees and respectfully directs the Board's attention to at least Col. 255, line 60-Col. 256, line 11, Col. 259, lines 12-25, Col. 260, line 43-Col. 261, line 48.

Concerning claim 20, Argument H, Appellant argues, page 22, that Ginter does not disclose or anticipate an excerpt of the data item that is used by the buyer to review the data item before downloading the data item, said method further comprising the step of downloading an electronic file containing the excerpt to the buyer. The Examiner respectfully disagrees and directs the Board's attention to at least Col. 200, lines 25-36.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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James Zurita
22 November 2004

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